IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reissue patent application of:

Plachetka, *et al.*

Appl. No.: To be assigned
(For reissue of Patent No.: 6,479,551)

Filed: Herewith

For: **Treatment of Migraine Headache**

Art Unit: To be assigned
(Formerly 1616)

Examiner: To be assigned
(Formerly F. Choi)

Atty. Dkt.: 7569/80993

Power of Attorney from Assignee and Revocation of Prior Powers

Commissioner of Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, **MS Reissue**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Pozen Inc. is the Assignee of the entire right, title and interest in the above-identified patent by virtue of an Assignment recorded in the U.S. Patent and Trademark Office on March 3, 2000 on Reel 010658, Frame 0594.

Pozen Inc. hereby revokes all previous powers and appoints: Kendrew H. Colton, Reg. No. 30,368; Francis A. Even, Reg. No. 16,880; Stephen S. Favakeh, Reg. No. 36,798; Karl R. Fink, Reg. No. 34,161; Morgan L. Fitch, Jr., Reg. No. 17,023; John F. Flannery, Reg. No. 19,759; James J. Hamill, Reg. No. 19,958; Mark W. Hetzler, Reg. No. 38,183; Ramon R. Hoch, Reg. No. 34,108; Robert B. Jones, Reg. No. 20,135; Richard A. Kaba, Reg. No. 30,562; James P. Kreuger, Reg. No. 35,234; Norman N. Kunitz, Reg. No. 10,586; Timothy E. Levstik, Reg. No. 30,192; Timothy P. Maloney, Reg. No. 38,233; Bruce R. Mansfield, Reg. No. 29,086; Steven G. Parmelee, Reg. No. 28,790; Philip T. Petti, Reg. No. 31,651; Kenneth H. Samples, Reg. No. 25,747; Michael A. Sanzo, Reg. No. 36,912; Joseph E. Shipley, Reg. No. 31,137;

James J. Schumann, Reg. No. 20,856; George H. Spencer, Reg. No. 18,038; Julius Tabin, Reg. No. 16,754; and Richard E. Wawrzyniak, Reg. No. 36,048, all registered to practice before the Patent and Trademark Office, as its attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in the United States Patent and Trademark Office connected therewith. Pozen Inc. requests that all correspondence and telephone communications be directed to the following person at the mailing address and telephone number hereafter given:

Name:	Michael A. Sanzo
Registration No.:	36,912
Address:	Fitch, Even, Tabin & Flannery 1801 K Street, N.W., Suite 401L Washington, D.C. 20006-1201
Telephone No.:	(202) 419-7013

The undersigned hereby states that he is empowered to sign this document on behalf of the Assignee.

POZEN INC.

By _____
John R. Plachetka
Chairman, President & CEO

Date March 23, 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Plachetka, *et al.*
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REISSUE DECLARATION

The undersigned hereby declares that:

1. The residence, mailing address and citizenship of the inventors are as stated below.

2. Pozen Inc. is the Assignee of the entire right, title and interest in U.S. 6,479,551 which issued on November 12, 2002.

3. I am authorized to act on behalf of Pozen Inc. and the title of my position at this company is: Chairman, President & CEO.

4. I believe that the inventors listed below are the original and first inventors of the subject matter which is described and claimed in U.S. 6,479,551 as amended by the Preliminary Amendment attached hereto and for which a reissue patent is sought. The specification of U.S. 6,479,551 is attached hereto.

5. The inventors referred to herein are as follows:

Name:	John R. Plachetka
Residence:	321 Silver Creek Trail Chapel Hill, North Carolina 27514
Citizenship:	United States
Post Office Address:	321 Silver Creek Trail Chapel Hill, North Carolina 27514

Name:	Zakauddin T. Chowhan
Residence:	2 Case Street Gaithersburg, Maryland 20878
Citizenship:	United States
Post Office Address:	2 Case Street Gaithersburg, Maryland 20878

6. I have reviewed and understand the contents of the above-identified patent for which reissue is sought, including its specification and claims as amended by the Preliminary Amendment referred to above.

7. I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56.

8. I believe the originally issued patent U.S. 6,479,551 to be wholly or partly inoperative or invalid by reason of its claiming more than the inventors had a right to claim.

9. At least one error upon which reissue is based is that claims 1 and 2 in issued patent U.S. 6,479,551 encompass compositions containing metoclopramide and either a non-acidic analgesic (claim 1) or a non-acidic NSAID (claim 2). Poyser (U.S. 4,325,971) discloses metoclopramide in combination with the non-acidic NSAID paracetamol in a manner that I believe renders claims 1 and 2 invalid for failing to meet the novelty requirement of patentability. Although the Poyser reference was cited during the prosecution of the application that issued as U.S. 6,479,551, Applicants failed to previously recognize the anticipatory nature of this reference. In order to correct this error, claims 1 and 2 have been cancelled in the Preliminary Amendment attached hereto.

10. All errors connected with this reissue application arose without any deceptive intent on the part of the Applicants.

11. I further declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POZEN INC.

Date March 23, 2004

By _____
John R. Plachetka
Chairman, President & CEO
1414 Raleigh Road, Suite 400
Chapel Hill, NC 27517

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reissue patent application of:

Plachetka, *et al.*

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Examiner: To be assigned
(Formerly F. Choi)

Atty. Dkt.: 7569/80993

Consent of Assignee to Reissue

Commissioner of Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, **MS Reissue**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Pozen Inc. is the owner of the entire right, title and interest in the patent identified above as evidenced by an Assignment transferring all rights in the application to Pozen Inc. from the inventors. This Assignment was recorded in the U.S. Patent and Trademark Office on March 3, 2000, on Reel 010658, Frame 0594. A Statement Under 37 C.F.R. § 3.73(b) is enclosed herewith.

Pozen Inc. hereby consents to the accompanying application for reissue of the above-identified patent. The undersigned hereby states that he is empowered to sign this document on behalf of the Assignee.

POZEN INC.

By _____
John R. Plachetka
Chairman, President & CEO

Date March 23, 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Statement Under 37 C.F.R. § 3.73(b)

Commissioner of Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, **MS Reissue**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Pozen Inc., a United States corporation, states that it is the Assignee of the entire right, title and interest in the patent identified above by virtue of an Assignment from the inventors that was recorded in the U.S. Patent and Trademark Office on March 3, 2000 on Reel 010658, Frame 0594. The undersigned (whose title is supplied below) is authorized to act on behalf of the Assignee.

POZEN INC.

By _____
John R. Plachetka
Chairman, President & CEO

Date March 23, 2004

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Declaration of Michael A. Sanzo

Commissioner of Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, **MS Reissue**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

I, the undersigned, Michael A. Sanzo, state the following pertinent facts with regard to the prosecution of the application that issued as U.S. 6,479,551:

1. I am a patent attorney registered to practice before the U.S. Patent and Trademark Office (Reg. No. 36,912). I am presently employed in the Washington Office of the firm Fitch, Even, Tabin & Flannery.

2. I am the attorney of record for application 09/517,751 (hereinafter "the '751 application") which issued on November 12, 2002 as U.S. 6,479,551 (hereinafter "the '551 patent").

3. The '551 patent was a continuation-in-part of U.S. application 08/966,506 (hereinafter "the '751 parent application") which issued as U.S. 6,077,539. I was the attorney responsible for revising the '751 parent application prior to filing and for the prosecution of the '751 application. Although I did not draft the '751 parent application, I was an attorney responsible for its prosecution.

4. A division of the '751 application was filed on September 26, 2002 (referred to hereinafter as "the '751 divisional application"). This received application no. 10/255,036. I was the attorney responsible for filing this divisional application and am presently the attorney responsible for its prosecution.

5. After the issuance of the '551 patent, I became aware that I had misinterpreted a reference by Poyser (U.S. 4,325,971) that was cited during prosecution of the '751 application. As a result, certain arguments that I made in response to Office Actions were erroneous. The errors were made entirely without deceptive intent. However, I now believe that the Poyser reference renders claims 1 and 2 in the issued '551 patent invalid on novelty grounds.

6. Poyser discloses a drug tablet in which paracetamol and metoclopramide are combined. Paracetamol is acetaminophen and has a basic pKa. However, during prosecution, I was under the mistaken belief that paracetamol had an acidic pKa. Arguments that Poyser does not disclose the combination of a non-acidic NSAID and metoclopramide were therefore incorrect. Since the prior art disclosure of a single species falling within the scope of a generic claim renders the claim invalid, claims 1 and 2 in the issued '551 patent appear to me to be invalid.

7. I first became aware of my error with respect to the Poyser reference in connection with the prosecution of the '751 divisional application. In response to an Office Action in that case which cited the Poyser reference, I prepared a draft response with arguments similar to those used in connection with the '751 application. Upon review, my client, Pozen Inc., recognized for the first time that this argument was incorrect and informed me that paracetamol actually has a non-acidic pKa. Upon learning this information, I reviewed the prosecution history of the '551 patent and advised my client that we should file a reissue application bringing this and any other errors to the attention of the Examiner.

8. Based upon my review of the prosecution of the '751 application, I believe that my misinterpretation of the Poyser reference led to the following erroneous statements:

a) In Applicants' response filed October 4, 2001, page 5, lines 1-3, read: "None of the references that have been cited by the Examiner disclose dosage forms which utilize a non-acidic analgesic in combination with metoclopramide or which keep metoclopramide and analgesic separately compartmentalized." Since Poyser does, in fact, disclose the combination of a non-acidic NSAID and metoclopramide, this statement is incorrect.

b) In Applicants' response filed on October 4, 2001, page 8, last line – page 9, line 2 reads: "The reference by Poyser is concerned solely with short-acting analgesic agents and, as discussed previously, the results that were obtained would be likely to change substantially depending on the length at which dosage forms were stored." For preparations containing the non-acidic NSAID paracetamol, there should not have been a substantial loss in activity upon storage, and this statement is therefore erroneous.

c) In Applicants' response filed on March 18, 2002, page 7, the second sentence in the last paragraph reads: "The two references that are cited in rejecting claims 1-10 (Saadah, *Headache 32*:95-97 (1992) and Poyser, U.S. 4,325,971) do not disclose such a combination [non-acidic analgesic with metoclopramide] and therefore cannot constitute an anticipation." Since Poyser discloses the combination of a non-acidic NSAID with metoclopramide, it appears to serve as an anticipation of the generic claims that issued as claims 1 and 2 in the '551 patent.

9. In addition to reviewing the prosecution history of the '751 patent for statements relating to the Poyser reference, Applicants also looked for any other statements that might have been erroneous, unclear, or which might have been misinterpreted by the Examiner. Based upon this review, I would also like to clarify the following points:

a) In Applicants' response of October 4, 2001, page 4, third sentence in the first paragraph reads: "Further investigation revealed that degradation was only a

significant problem when the analgesic being used was acidic, *i.e.*, when it had a pKa of less than 7.0." Similarly in Applicants' response of March 18, 2002, page 7, second sentence in the second paragraph reads: "It was also found that degradation does *not* occur when a non-acidic analgesic is used in place of an acidic one." It should be pointed out that actual experiments were only performed using acidic NSAIDS in combination with metoclopramide. Conclusions regarding non-acidic NSAIDS were based upon a consideration of the chemical properties of compounds.

b) In Applicants' response of October 4, 2001, page 6, last line prior to the quotation, tolfenamic acid is referred to as a "non-analgesic." This appears to have been a typographical error in that tolfenamic acid is, in fact, an analgesic.

c) In discussing the Saadah reference on page 9 of Applicants' response of October 4, 2001, several commercially available drug preparations are mentioned. I have double-checked the composition of these preparations. Maxalon and Reglan do contain 10 mg metoclopramide in the form of metoclopramide hydrochloride. Anaprox and Synflex both contain 550 mg of naproxen sodium. (The 550 mg preparation of Synflex is sometimes referred to as Synflex DS.) However, it should be pointed out that "Naprosyn" contains 500 mg naproxen base. I believe that, in terms of efficacy, this is equivalent to 550 mg of naproxen sodium but there may be other differences and, in any event, it does not appear that Naprosyn matches the compounds described by Saadah in the same way as the Anaprox and Synflex products. Cafergot and Ercaf do contain 1 mg of ergotamine tartrate and 100 mg caffeine, but I was unable to find information that would either confirm or refute the content of Temigran. Therefore, although I do not believe that this significantly affects the basic arguments that were made, reference to Naprosyn and Temigran should be deleted. Also, it should be pointed out that the argument does not attempt to list all relevant products. There may be additional products that are essentially the same as Reglan, Anaprox and Cafergot

with respect to content of metoclopramide, naproxen and ergotamine tartrate/caffeine.

10. As far as I am presently aware, all other information provided during the prosecution of the '751 application is accurate, and, I believe, clear. I want to emphasize that any and all errors that occurred during prosecution of '751 were made entirely without deceptive intent.

11. The Examiner is respectfully requested to carefully take into account all of the information contained herein when considering the patentability of the claims pending in the present reissue application. If there are any points in need of further clarification or if the Examiner has any questions concerning the points raised herein or any other issues concerning the prosecution of '751 or the present reissue application, Applicants will be happy to provide all the information that they can.

12. I further declare that all statements made herein on the basis of personal knowledge are true, and all statements made on information and belief are believed to be true; and further that any willful false statements or the like so made are punishable by fine or imprisonment or both under Section 1011 of Title XVIII of the United States Code; and that such willful false statements may jeopardize the validity of the above-captioned application or any patent issuing thereon.

Respectfully submitted,

By: Michael A. Sanzo

Michael A. Sanzo
Reg. No. 36,912
Attorney for Applicant

Date: March 26, 2004

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